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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,710	12/01/2000	Volker Schreiner	Beiersdorf 688-VMM	7950

7590 05/05/2004

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/701,710

**Applicant(s)**

SCHREINER ET AL.

**Examiner**

Lauren Q Wells

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-12 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-12 and 27-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 5-12 and 27-31 are pending.

Regarding the charted prosecution in the instant response by Applicant, it is respectfully pointed out that some confusion did arise in the transition of prosecution from Examiner to Examiner. However, the previous and instant rejections are comprehensive and properly applied. Hence, the reasons for re-opening prosecution following the filing of Applicant's appeal brief.

#### ***112 Rejection Maintained***

The rejection of claims 5-12 and 27-31 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed 10/3/03, and those found below.

Applicant argues, "it is unclear what is the basis for the examiner's holding of new matter". This argument is not persuasive. The Examiner respectfully directs Applicant to page 286 of Biochemistry by Garret and Grisham. Ceramides are produced by the reaction of sphingosine and fatty alcohols. Increasing the rate of sphingosine production does not inherently increase the rate of ceramide synthesis, as the reaction to form a ceramide requires more reactants than just the sphingosine, i.e., the fatty acid.

#### ***103 Rejection Maintained***

The rejection of claims 5-12 and 27-31 under 35 U.S.C. 103(a) as being unpatentable over Kurose et al. (Pl 9303217) is MAINTAINED for the reasons set forth in the Office Action mailed 10/3/03, and those found below.

Applicant argues, "Kurose does not teach that 'catechins provide various benefits which as skin softening, skin moisturizing and emolliency'. The only specific recitation of effect which is attributed to catechins alone is anti-oxidant activity (see page 4). The statement made by the

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examiner appears to refer to the extract as a whole”. This argument is not persuasive. See for Example, page 8 of Kurose, which teaches “Cosmetic products for skin or hair with the principal function of moisture conservation” comprising “0.1 to 0.5% MTE-1”, wherein page 3 of Kurose specifically teaches catechins as members of MTE-1. The Examiner further points out that Applicant’s open-ended language does not exclude additional ingredients from the instant composition. For this reason alone, Kurose’s teaching of a composition comprising MTE-1 for skin moisturization, meets the limits of the instant claims.

Applicant argues, “There is no indication how much catechins are actually in this 20.3% range and the examiner has not established any factual basis for presuming the ranges claimed by the applicants for their method of use is taught or suggested by Kurose”. This argument is not persuasive. First, it is respectfully pointed out that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It is respectfully pointed out that Applicant has not established any criticality of the instant ranges or difference between the instant ranges and those of Kurose. Second, it is respectfully pointed out that the catechins taught by Kurose are one of the major constituents of his composition.

Applicant argues, “for both of the decisions cited by the examiner the issue at hand was a comparison of the claimed composition with the prior art compositions, this is not the case here; all of the claims are directed toward method of using claims”. This argument is not persuasive. As pointed out in the previous Office Action, applying the same composition in the same effective amount to the skin, results in the same affect, especially since Kurose teaches his method for skin moisturization and the end result of the instant method claims is moisturization

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of the skin. Thus, while not explicitly stated, since the method steps are the same, their effect is the same.

Applicant argues, "such a reversal of positions cannot be explained away by changes in examiners or by changing subject matter within the claims". This argument is not persuasive. First, it is respectfully pointed out that there is nothing unusual, certainly, about an Examiner changing his viewpoint as the prosecution of a case progresses, and, so long as the rules of the Patent Office Practice are duly compiled with, an applicant has no legal complain because of such change in view. In re Ellis, 31 USPQ 380; In re Becker, 40 USPQ 624. Second, for reasons of record, the instant rejection has been applied because the Kurose et al. reference makes the instant invention obvious. Does not Applicant want a valid patent that is free from prior art?

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

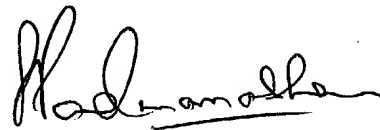
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**